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09/742,155	12/20/2000	Peter Pesch	000434	9679

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86 Sparks Street  
Cambridge, MA 02138-2216

EXAMINER

FELTEN, DANIEL S

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 06/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/742,155

Applicant(s)

PESCH, PETER

Examiner

Daniel S. Felten

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 20 December 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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## DETAILED ACTION

### *Claim Rejections - 35 USC § 101*

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The claimed invention is directed to non-statutory subject matter. Claims 1-18 provide no technology (i.e., computer, data processor, etc) in the body of the claim. Since the body of the claim is not tied to technological art, environment or machine, the claim is not statutory [see *Ex Parte Bowman*, 61 USPQ, 61 USPQ2d 1665, 1671m (BD Pat, App & Inter 2001) (Unpub)]. A recitation of technology in the preamble, without any further tie to technology in the body of the claim that would provide technology in a non-trivial manner to the claimed subject matter does not breath “life and meaning” into the claim and thus, does not constitute a limitation. {*Kropa v. Robie*, 88 USPQ 478 (CCPA 1951). Since the limitation “computer implemented” in the preamble does not constitute a limitation and the body of the claim provides for not technology, the claimed invention lacks technology.

Moreover the analysis proved earlier, the invention in the body of the claim manipulates an Abstract idea without producing a “useful, concrete and tangible result”.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 5, 7, 12, 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Re claim 5: "...agent statistical data *is kept* and updated *about one of its* third party information and evaluation data". What do you mean when you say the data "is kept?" Are you trying to say that the data is being stored in some sort of memory or database?

Re claims 12 and 13: What is the criteria for what you referring to as "quality" of information being received by the third party? How is "quality" determined?

4. Claims 3 recites the limitation "*the M*" in the claims. There is insufficient antecedent basis for this limitation in the claim.

5. Claims 5 and 7 recites the limitation "*its*" in the claims. There is insufficient antecedent basis for this limitation in the claim.

6. Claims 12 and 13 recites the limitation "*the quality*" in the claims. There is insufficient antecedent basis for this limitation in the claim.

*Claim Rejections - 35 USC § 102*

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-38 are rejected under 35 U.S.C. 102(b) as being anticipated by Walker et al (US 5,794,207).

*Re claims 1, 19 and 38*, Walker discloses a device with a computer program for receiving and storing third party information (*Conditional Purchase Offer—CPO--100*) via a computer system (*central controller--200*) for controlling communication between at least one first contracting party (*buyer--450*) and potential second contracting party (*seller—300,350*) on the basis of third party information from an agent (*central controller*) the third party information including at least the identity of the at least one first contracting party and a description of the contractual subject matter (see fig. 1, Abstract; col. 11, lines 51+; and col. 13, ll. 23-29), providing access to the contractual subject matter of the third party information for queries by second contracting parties (*sellers*) via a first data base with a input interface for the agent by which the third party information is received, the data base being provided with a public and a private section provide with an input interface for the agent by which the third a party information is received, the first data base being provided with a private section and a public section, at least the identity of the first contracting party being stored in the private section and description of the contractual

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subject matter being stored in the public section, and further (see Abstract, col. 8, ll. 66 to col. 9, ll. 16);

receiving bids from second contracting parties for access to the identity of the first contracting party, each bid including at least a statement of a closing fee offered by the second contracting party for closing a contract with the first contracting party (see Abstract, col. 8, ll. 66 to col. 9, ll. 16);

receiving a bid fee for each bid from each second contracting party making a bid and storing the bids and bid fees (see col. 20, ll. 16-29);

and determining the bids with the N highest statements of closing fees at a predetermined time with  $N \geq 1$ ; transmitting the identity of the first contracting party to the N second contracting parties making the N bids; and transmitting at least a portion of all bid fees to the agent (see col. 20, ll. 16-29);

transmitting the identity of the first contracting party to the N second contracting parties making the N bids (see col. 20, ll. 16-29);

and transmitting at least a portion of all bid fees to the agent (see col. 20, ll. 16-29).

**Re claims 2, 5, 20, 21, 24,** Receiving evaluation data relative to the third party information within a predetermined interval of time (see col. 8, ll. 66 to col. 9, ll. 16).

If an evaluation data indicates that a contract has been closed between the first contracting party and one of the second contracting parties, receiving the closing fee including in the bid of the

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particular second contracting party and transmitting at least a share thereof to the agent ( see col. 9, ll. 17+)

If no evaluation data indicates closing of a contract, but evaluation data is received from a majority of the second contracting parties which have made the N bids, recovering the bid fees from the agent and returning them to the second contracting parties (see col. 21, ll. 1-22),

**Re claims 3, 4, 22 and 23**, wherein only bids comprising the M biggest statements of bid fees are admitted for determining the N bids, wherein  $M \geq N$  (see col. 21, ll. 1-22)

Wherein only bids the bid fee which exceeds a predetermined threshold value are considered for determining the N bids (see col. 21, ll. 1-22),

**Re claim 6 and 25**, Wherein at least one of the share of the bid fees and the share of the closing fee is determined on the basis of the statistical data (see col. 16, ll. 12-45; col. 20, ll. 5-29).

**Re claim 7 and 26**, Wherein for every second contracting party submitting a bid there is maintained and updated statistical data regarding at least one of its and evaluation data (see col. 16, ll. 12-45).

***Re Claim 8 and 27:***

wherein the bid fee is set on the basis of the statistical data and is accepted upon placement of a bid by the second contracting party (see col. 16, ll. 12-45).

***Re Claim 9 and 28,*** wherein the second contracting parties are classified and the bid fee of a party is determined by the classification of that party (see col. 16, ll. 12-45),

***Re claim 10 and 29,*** wherein a statement of the amount of its bid fee is received in step c) from the second contracting party (see col. 21, ll. 1-22).

***Re claim 11 and 30,*** wherein N and the description of the contractual subject matter are made available for querying (see *subject categories* and *web-browsing*, col. 8, ll. 66 to col. 9, ll. 16).

***Re claim 12 and 31,*** wherein the third party information includes a statement relating to the quality of the information which is made available for querying together with the description of the contractual subject matter (see *scoring*, col. 16, ll. 12-45)

***Re claim 13 and 32,*** wherein the statement relating to the quality of the information includes a statement of its origin (see *scoring*, col. 8, ll. 66 to col. 9, ll. 16; and col. 16, ll. 12-45; ).



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**Re claim 14 and 33**, wherein during storage the description of the contractual subject of the third party information matter is classified in accordance with predetermined classes (see *subject categories*, col. 8, ll. 66 to col. 9, ll. 16)

**Re claim 15 and 34**, wherein the third party information is classified by means of an expert system for guiding the agent (see col. 8, ll. 66 to col. 9, ll. 16)

**Re claim 16 and 35**, wherein the bid fee is determined on the basis of the classification of the description of the contractual subject matter (see *discounted price based upon CPO*, col. 20, ll. 16-30).

**Re claim 17 and 36**, wherein the second contracting parties are classified and access to the description of the contractual subject matter by a predetermined second contracting party is only granted in dependence of the classification of the predetermined second contracting party (see *subject categories*, col. 8, ll. 66 to col. 9, ll. 16)

**Re claim 18 and 37**, wherein the reception of bids from a predetermined second contracting party is only granted in dependence of the classification of the predetermined second contracting party (see *subject categories*, col. 8, ll. 66 to col. 9, ll. 16).

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*Conclusion*

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patents:

Bi et al (US 6,311,178) discloses multi-element confidence matching system and the method thereon

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel S. Felten whose telephone number is (703) 305-0724. The examiner can normally be reached on Flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703) 308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



DSF  
June 14, 2005

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